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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,396	10/18/2001	Amr Salahieh	1001.1505101	1306

28075 7590 03/01/2005

CROMPTON, SEAGER & TUFTE, LLC  
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MINNEAPOLIS, MN 55403-2420

EXAMINER

HO, UYEN T

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/001,396		SALAHIEH ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	(Jackie) Tan-Uyen T. Ho		3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-80 is/are pending in the application.
- 4a) Of the above claim(s) 3, 12-24, 34-70, 73, 74 and 78-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11, 25-33, 71, 72 and 75-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.
2. The indicated allowability of claims is withdrawn in view of the newly discovered reference(s) to Tsugita et al. (6,371,971). Rejections based on the newly cited reference(s) follow.

### *Election/Restrictions*

3. Claim 3 and 73, 78-80 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species IV (claim 3) and II (claim 73), and another species (figs. 6-7, claims 78-80) there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/7/04.
4. This application contains claims 3, 12-24, 34-70, 73, 74 and 78-80 drawn to an invention nonelected with traverse filed on 5/7/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4-9, 11, 25-33, 71-72, 75-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsugita et al. (6,371,971). Tsugita et al. disclose an embolic protection system comprising: a guidewire (30), a filter (110) on the sleeves (111, 112) slidably over the guidewire, first stop mechanism (166, 167), a second stop mechanism (102). Wherein the first stop mechanism are deformable with at least one strand/cleat (168) so that a filter may advance from proximal to distal and from distal to proximal with a sufficient force being applied to pivot the stop. The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the Tsugita et al.'s device which is capable of being used as claimed if one desires to do so. The limitation "one-way" does not impose any structural limitation on the claims distinguishable over the Tsugita et al.'s device. With sufficient force being applied to compress the strands 23 of the present invention to its straight configuration, the filter can be passed from proximal to distal or from distal to proximal of the guidewire.

4. Claims 1, 4, 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Khosravi (6,129,739). Khosravi disclose a guidewire (132) including a first stop mechanism (145) and claimed (see figure 8), a second stop mechanism (146), a filter (136) attached to a sleeve (143), the sleeve slidably disposed on the guidewire. Although, the sleeve is not slidable over the first and second stop mechanism, the sleeve is inherently slidable between the stop mechanism (Fig. 11A).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsugita et al. (6,371,971). Tsugita et al. do not disclose the material for making the stop having deformable cleats, Nitinol is a well-known material in the art for making medical device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make Tsugita et al.'s first stop mechanism from Nitinol, doing so would amount to mere substitution of one material for an other within the same art that would perform equally well in Tsugita et al.'s device.

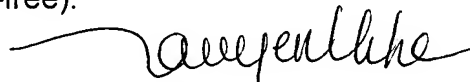
9. Claims 5-9,11,28-33, 71-72, 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khosravi (6,129,739) in view of Tsugita et al. (6,371,971). Khosravi disclose all the limitations of the claims except for a present of a one-way translation member as claimed. Tsugita et al. disclose a deformable translation member comprising all the limitations of the one-way translation member as claimed allowing the filter to pass over the member from proximal to distal and distal to proximal along the guidewire. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the stop members of Khosravi by having the stop member/members with deformable configuration as disclose by Tsugita et al. in order to allow the filter easily being placed on or removed from the guidewire.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho  
Patent Examiner  
Art Unit 3731

February 25, 2005